

U.S. Application No. 09/658,778

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REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1-17 were pending prior to this Reply. In this Reply, claims 18-21 have been added. Therefore, claims 1-21 are pending. Claims 1 and 8 are independent.

OBJECTION TO THE SPECIFICATION

The Examiner maintained his objection to the specification under 35 U.S.C. §132 as allegedly introducing new matter. More specifically, it is alleged that the added material "and another is the Synchronous Digital Hierarchy (SDH) standard used in Europe that has many similarities and is generally equivalent to SONET" is new matter.

Applicant respectfully disagrees. Applicant demonstrated in the Rule 116 Reply filed on February 23, 2004 that one of ordinary skill would realize that the SONET and SDH are equivalent and thus the added material merely makes explicit what was generally known. Therefore, the added material does NOT introduce new matter.

The MPEP also states that a mere inclusion of art-recognized definitions known at the time of filing of an application would not be considered new matter. See *M.P.E.P.* §2163.07.

Therefore, Applicant respectfully requests that the objection to the specification be withdrawn.

§ 112, 1st PARAGRAPH REJECTION

Claims 1-17 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. More specifically, it is alleged that change from "SONET" to "SONET/SDH" is grounds for new matter.

As noted above, it was generally known at the time the present invention was made that the two standards are generally equivalent. Furthermore, the MPEP also states that a mere inclusion of art-recognized definitions known at the time of filing of an application would not be considered new matter. See *M.P.E.P.* §2163.07. Therefore, no new matter has been introduced.

Applicant respectfully requests that the Section 112, 1st paragraph rejection be withdrawn.

§ 102 REJECTION - CHEN

Claims 1-14 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Chen et al. (USPN 6,501,758, hereinafter "Chen"). Applicant respectfully traverses.

Applicant maintains all traversal arguments presented in the Replies filed on July 24, 2003 and February 23, 2004 with respect to claims 1-14.

In addition, independent claims 1 and 8 recite, in part, "subdividing a payload portion of at least one of the SONET/SDH data frames comprising a SONET/SDH layer into two or more logical channels, each logical channel having associated therewith a predetermined bandwidth capacity." Chen cannot be relied upon to teach or suggest at least this feature.

The Examiner never explicitly stated what feature of Chen he considers to be equivalent to the logical channels as claimed. From the discussion in the office actions, it appears that the Examiner considers the ATM and TDM information as being equivalent to the logical channels as claimed. Applicant does not necessary agree with such assertion. However, for the sake of argument only, Applicant will respond accordingly below.

The following is noted with regard to Chen. To the extent that payload is discussed at all, Chen strongly suggests that each payload carries only one type of information - either ATM or TDM. In other words, both types **cannot be part of a single payload.**

For example, Chen states, "STM switching fabric maps outgoing signals carrying TDM information bound for a common destination in to a synchronous payload envelop encoded with overhead information specifying that destination." Likewise, Chen states, "ATM switching fabric 24 maps signals having common destination into a synchronous envelop encoded with overhead with overhead information specifying the cell's destination." In other words, at best, each type of information - whether TDM or ATM - are mapped to a particular payload **separate** from each other.

Indeed, Chen is replete with examples of separate payload mapping. For example, in the embodiment shown in Figure 2b of Chen, the ATM and TDM traffic are separated on physically separate paths. As shown, the ATM traffic are carried on a physical fiber path 213a (*column 8, lines 24-26*) and TDM traffic are carried on paths 213b-213c (*column 8, lines 11-13*). Clearly,

if TDM and ATM signals are carried on physically separate paths, it is impossible for any single payload to include both types of information.

The other embodiment of Chen which discusses "channels" is the embodiment as shown in Figure 2d. It is noted that Figure 2d shows multiple "channels" 413a-413l that may be carried within a single fiber ring 412a. Chen discloses that channels 413a and 413g may be dedicated to carry ATM information, channels 413b-413f are working channels to carry TDM traffic, and channels 413h-413l are protection channels for the TDM working channels. See *Chen, Figure 2d; column 8, line 65 - column 9, line 15.*

Two important points are noted. First, the channels 413a-413f as disclosed in Chen, at best, refer to individual carrier frequency channels, for example when wavelength division multiplexing scheme is used.

This is to be distinguished from the logical channels of the invention as claimed. The multiple logical channels of the claim inventions may be transmitted over a common carrier channel. Thus, the channels as depicted in Figure 2d have no relevance with respect to the logical channels as claimed.

Second, even if an unreasonable assertion of relevance is made, it is clear that Chen discloses each carrier channel is devoted to either TDM or ATM traffic, **but not both**. Thus, even Figure 2d cannot teach or suggest the feature of a single payload to include two or more logical channels as claimed.

Therefore, for at least the above reasons, independent claims 1 and 8 are not anticipated by Chen. Claims 2-7 and 9-14 depend directly or indirectly from independent claims 1 and 8. Therefore, for at least the reasons stated above with respect to independent claims 1 and 8, these dependent claims are also not anticipated by Chen.

Applicant respectfully requests that the rejection of claims 1-14 based on Chen be withdrawn.

§ 103 REJECTION - CHEN, BISSON

Claim 15 stands rejected under 35 U.S.C. §103(a) over Chen in view of Bisson et al. (USPN 6,349,092, hereinafter "Bisson"). Applicant respectfully traverses.

Applicant maintains all traversal arguments presented in the Replies filed on July 24, 2003 and February 23, 2004 with respect to claim 15.

In addition, it has been shown above that Chen may not be relied upon to teach or suggest all features of independent claim 8. Bisson has not been, and indeed cannot be, relied upon to correct all deficiencies of Chen. Therefore, claim 8 is distinguishable over Chen and Bisson. For at least due to its dependency from claim 8, claim 15 is also distinguishable over Chen and Bisson.

Applicant respectfully request that the rejection of claim 15 based on Chen and Bisson be withdrawn.

§ 103 REJECTION - CHEN

Claim 16 and 17 stand rejected under 35 U.S.C. §103(a) over Chen. Applicant respectfully traverses.

Applicant maintains all traversal arguments presented in the Reply filed on February 23, 2004 with respect to claims 16 and 17.

In addition, the Examiner's assertion that having STS-1 frames of Chen being non-contiguous or contiguous as being a design choice is without basis and cannot be used to sustain a *prima facie* case of obviousness.

The use of the "design choice" as a basis to establish a *prima facie* case of obviousness is very narrow. The only context in which "design choice" is mentioned is in rearrangement of parts of device.

See M.P.E.P. §2144.04. Even in this context, the rejection may be valid only if the rearrangement "would **not** have modified the operation of the device."

The Examiner failed to even assert, let alone provide a line of reasoning, that the context of rearrangement of parts is even applicable to claims 16 and 17. The Examiner also failed to assert, let alone provide a line of reasoning, that the operation of the device as claimed would not be modified whether the frames are contiguous or non-contiguous.

In addition, M.P.E.P. clearly states, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claim on appeal is not by itself sufficient to support a finding of obviousness. The prior art **must provide a motivation or reason** for the worker in the art, **without the benefit of appellants specification**, to make the necessary changes in the reference device."

The Examiner has failed to show that Chen provides motivation or reason for a worker in the art to make the necessary changes to achieve the features of claims 16 and 17 without the benefit of the Applicant's specification.

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Applicant respectfully request that the rejection of claims 16 and 17 based on Chen be withdrawn.

NEW CLAIMS

By this Reply, claims 18-23 have been added. Applicant respectfully submits that the new claims are distinguishable over all cited prior art of record, individually or in any combination. Applicant respectfully request that the new claims be allowed.

CONCLUSION

All objections and rejections raised in the Final Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant respectfully petitions for a second month extension of time (fee for first month extension already having been paid) for filing

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the Request for Continued Examination in connection with the present application, and the required fee of is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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